STATUTORY INSTRUMENTS

1985 No. 921

TRADE MARKS

The Trade Marks (Amendment) Rules 1985

Made - - - - -	14*th June* 1985
Laid before Parliament	17*th June* 1985
Coming into Operation	
Rules 1(1) *and* (2) *and* 3(2)	8*th July* 1985
Rules 1(3) *and* 3(1)	22*nd July* 1985
Rule 2	23*rd September* 1985

Whereas in pursuance of the requirements of section 40(3) of the Trade Marks Act 1938(**a**) the Secretary of State has, before making the following Rules under that Act, published notice of his intention to make such Rules and of the place where copies of the draft Rules might be obtained by advertising such notice in the Trade Marks Journal and the Official Journal (Patents) on 15th May 1985 and 22nd May 1985, being the manner which he considered most expedient so as to enable persons affected to make representations to him before the Rules were finally settled:

Now, therefore, the Secretary of State, in exercise of the powers conferred by sections 40 and 41 of the Trade Marks Act 1938 and now vested in him(**b**) and of all other powers enabling him in that behalf, after consultation with the Council on Tribunals pursuant to section 10(1) of the Tribunals and Inquiries Act 1971(**c**) and as to Rule 3 with the sanction of the Treasury pursuant to the said section 41, hereby makes the following Rules:—

1.— (1) These Rules may be cited as the Trade Marks (Amendment) Rules 1985 and shall come into operation as respects Rules 1(1) and (2) and 3(2) on 8th July 1985, as respects Rules 1(3) and 3(1) on 22nd July 1985 and as respects Rule 2 on 23rd September 1985.

(2) In these Rules "the principal Rules" means the Trade Marks Rules 1938(**d**).

(3) The Trade Marks (Amendment) Rules 1984(**e**) are hereby revoked.

(**a**) 1938 c.22.
(**b**) S.I. 1970/1537.
(**c**) 1971 c.62.
(**d**) S.R & O. 1938/661; relevant amending instruments are S.I. 1982/718, 1984/459.
(**e**) S.I. 1984/459.

2.— (1) In Rule 2(1) of the principal Rules, for the definitions of "the Office" and "the Manchester Branch" there shall be substituted the following:

" "the Office" means the Trade Marks Registry of the Patent Office.

"the Manchester Branch" means the Manchester Branch of the Office."

(2) In every form set out in Schedule II to the principal Rules the words "25 Southampton Buildings London, WC2A 1AY" and, wherever they occur, "Baskerville House, Browncross Street, New Bailey Street, Salford, M3 5FU" shall be omitted.

(3) In Note (1) to Schedule IV to the principal Rules the words "25, Southampton Buildings London, W.C.2 shall be omitted; and in Note (2) thereto, for all the words after "Patent Office" there shall be substituted "Trade Marks Registry or at the Manchester Branch of the Trade Marks Registry."

3.— (1) There shall be substituted as Schedule I to the principal Rules the Schedule hereto.

(2) Where on or after 8th July 1985 but before 22nd July 1985 Form T.M.—No.11 is filed in respect of the renewal of registration of a trade mark or a series of trade marks the last registration of which mark or series of marks is due to expire on or after 22nd July 1985, the fee payable in respect of such renewal shall be that which would be payable if the said form were filed on or after 22nd July 1985 and paragraph (1) of this rule had come into operation.

John Butcher,
Parliamentary Under Secretary of State,
Department of Trade and Industry.

7th June 1985.

We sanction the making of rule 3 of these Rules.

Donald Thompson,
Ian B. Lang,
Two of the Lords Commissioners
of Her Majesty's Treasury.

14th June 1985.

Rule 3(1)

SCHEDULE

SCHEDULE I

Rule 3

LIST OF FEES PAYABLE

	Matter or Proceeding	Amount	Corresponding Form
		£	
1	On application not otherwise charged to register a trade mark for a specification of goods included in one class	54	T.M.-No. 2 Textile-No. 2
1a	On application to register a series of trade marks under section 21(2) for a specification of goods included in one class	54	T.M.-No. 2 Textile-No. 2
1b	On application to register a defensive trade mark for a specification of goods included in one class	81	T.M.-No. 32
1c	On application under section 37 to register a certification trade mark for a specification of goods included in one class	70	T.M.-No. 6
1d	On applications made at the same time under section 37 to register one certification trade mark for specifications of goods not all included in one class— In respect of every class ..... Total fee in no case to exceed £1300 for any number of classes.	70	T.M.-No. 6
2	On request to the Registrar to state grounds of decision relating to an application to register a trade mark and materials used	75	T.M.-No. 5
3	On notice of opposition before the Registrar under section 18, for each application opposed, by opponent	27	T.M.-No. 7
3a	On lodging a counter-statement in answer to a notice of opposition under section 18, for each application opposed, by the applicant; or in answer to an application under any of the sections 26, 27, 32 and 33, by the proprietor in respect of each trade mark; or in answer to a notice of opposition under section 35 or section 36, for each application or conversion opposed, by the proprietor	16	T.M.-No. 8
3b	On the hearing of each opposition under section 18, by applicant and by opponent respectively; or on the hearing of an application under any of the sections 26, 27, 32 and 33, by applicant and by proprietor respectively; or on the hearing of an opposition under section 35 or section 36, by proprietor and by opponent respectively	27	T.M.-No. 9
3c	On notice of opposition under paragraph 2(2) of Schedule 1 to the Act, for each application opposed, by the opponent	27	T.M.-No. 37

LIST OF FEES PAYABLE (*Cont'd.*)

	Matter or Proceeding	Amount	Corresponding Form
		£	
3d	On lodging a counter-statement in answer to a notice of opposition under paragraph 2(2) of Schedule 1 to the Act, for each application opposed, by the applicant	16	T.M.-No. 38
3e	On the hearing of each opposition under paragraph 2(2) of Schedule 1 to the Act, by applicant and by opponent respectively	27	T.M.-No. 39
4	For one registration of a trade mark not otherwise charged for a specification of goods included in one class	75	T.M.-No. 10
4a	For one registration of a series of trade marks under section 21(2) for a specification of goods included in one class—		
	For the first mark	75	T.M.-No. 10
	And for every other mark of the series	4	
4b	For registration under section 37 of a certification trade mark for a specification of goods included in one class	75	T.M.-No. 10
4c	For registration upon applications made at the same time of one certification trade mark, under section 37, for specifications of goods not all included in one class—		
	In respect of every class	75	T.M.-No. 10
	Total fee in no case to exceed £1400 for any number of classes.		
4d	For one registration of a defensive trade mark for a specification of goods included in one class	75	T.M.-No. 10
5a	On application to dissolve the association between registered trade marks	23	T.M.-No. 19
6	On application to register a registered user of a registered trade mark in respect of goods within the specification thereof	43	T.M.-No. 50
6a	On application to register the same registered user of more than one registered trade mark of the same registered proprietor in respect of goods within the respective specifications thereof and subject to the same conditions and restrictions in each case—		
	For the first mark	43	T.M.-No. 50
	And for every other mark of the proprietor included in the application and statement of case	4	
6b	On application by the proprietor of a single trade mark under section 28(8)*(a)* to vary the entry of a registered user thereof	43	T.M.-No. 51
6c	On application by the proprietor of more than one trade mark under section 28(8)*(a)* to vary the entries of a registered user thereof—		
	For the first mark	43	T.M.-No. 51

LIST OF FEES PAYABLE (*Cont'd.*)

	Matter or Proceeding	Amount	Corresponding Form
		£	
	And for every other mark of the proprietor for which the same user is registered, included in the application	4	
6d	On application by the proprietor or registered user of a single trade mark under section 28(8)*(b)*, for cancellation of the entry of a registered user thereof	16	T.M.-No. 52
6e	On application by the proprietor or registered user of more than one trade mark under section 28(8)*(b)*, for cancellation of the entries of a registered user thereof—		
	For the first mark	16	T.M.-No. 52
	And for every other mark of the proprietor for which the same user is registered, included in the application	4	
6f	On application under section 28(8)*(c)*, to cancel the entry of a registered user of a single trade mark	16	T.M.-No. 53
6g	On application under section 28(8)*(c)*, to cancel the entries of a registered user of more than one trade mark—		
	For the first mark	16	T.M.-No. 53
	And for every other mark of the same proprietor for which the same user is registered, included in the application	4	
6h	On notice under section 28(9) and Rule 112, of intention to intervene in one proceeding for the variation or cancellation of entries of a registered user of trade marks	27	T.M.-No. 54
7	On request to enter in the register and advertise a certificate of validity, under section 47 and Rule 88—		
	For the first registration certified	11	T.M.-No. 49
	And for every other registration certified in the same certificate	4	
7a	On application under section 29(4) and Rule 76 for extension of time for registering a corporation as subsequent proprietor of trade marks on one assignment—		
	Not exceeding two months	16	T.M.-No. 14
	Not exceeding four months	30	T.M.-No. 14
	Not exceeding six months	45	T.M.-No. 14
8	On application for certificate of the Registrar, under section 22(5) and Rule 79—		
	For the first mark proposed to be assigned	30	T.M.-No. 40
	And for every other mark of the same proprietor included in that assignment	4	
8a	On application for approval of the Registrar, under section 22(6) or paragraph 2 of Schedule 3 to the Act, and Rule 79—		
	For the first mark	30	T.M.-No. 41 or 42

LIST OF FEES PAYABLE (*Cont'd.*)

	Matter or Proceeding	Amount	Corresponding Form
		£	
	And for every other mark of the same proprietor included in the same transfer	4	
8b	On application for directions by the Registrar for advertisement of assignment of trade marks in use, without goodwill—		
	For one mark assigned	16	T.M.-No. 43
	And for every other mark assigned with the same devolution of title	4	
8c	On application for extension of time for applying for directions for advertisement of assignment of trade marks in use. without goodwill, in respect of one devolution of title—		
	Not exceeding one month	16	T.M.-No. 44
	Not exceeding two months	30	T.M.-No. 44
	Not exceeding three months	45	T.M.-No. 44
9	On application to register a subsequent proprietor in a case of assignment or transmission of a single trade mark—		
	If made within six months from the date of acquisition of proprietorship	16	T.M.-No. 15 or 16
	If made after expiration of six months but within twelve months from the date of acquisition of proprietorship	36	T.M.-No. 15 or 16
	If made after expiration of twelve months from the date of acquisition of proprietorship	59	T.M.-No. 15 or 16
9a	On application to register a subsequent proprietor of more than one trade mark standing in the same name, the devolution of title being the same in each case—		
	If made within six months from the date of acquisition of proprietorship—		
	For the first mark	16	T.M.-No. 15 or 16
	And for every other mark	4	
	If made after the expiration of six months but within twelve months from the date of acquisition of proprietorship—		
	For the first mark	36	T.M.-No. 15 or 16
	And for every other mark	4	
	If made after expiration of twelve months from the date of acquisition of proprietorship—		
	For the first mark	59	T.M.-No. 15 or 16
	And for every other mark	4	
10	On application to change the name or description of a proprietor or a registered user of one or more trade marks where there has been no change in the proprietorship or in the identity of the user—		
	For each mark	6	T.M.-No. 21
11	For renewal of registration of a trade mark at expiration of last registration	188	T.M.-No. 11

LIST OF FEES PAYABLE (*Cont'd.*)

	Matter or Proceeding	Amount	Corresponding Form
		£	
11a	For renewal of registration of a series of trade marks under section 21(2) at expiration of last registration—		
	For the first mark of the series	188	T.M.-No. 11
	And for every other mark of the series	4	
11b	For renewal of registrations of the same certification trade mark with the same date for goods in more than one class—		
	In respect of every class	188	T.M.-No. 11
	Total fee in no case to exceed £3500 for any number of classes.		
11c	Additional fee under Rule 67	27	T.M.-No. 12
11d	Restoration fee under Rule 68	70	T.M.-No. 13
12	On application to the Registrar for leave to add to or alter a single registered trade mark	30	T.M.-No. 25
12a	On application to the Registrar for leave to add to or alter more than one registered trade mark of the same proprietor, being identical marks, the addition or alteration to be made in each case being the same—		
	For the first mark	30	T.M.-No. 25
	And for every other mark	16	
12b	On notice of opposition to application for leave to add to or alter registered trade marks, for each application opposed	27	T.M.-No. 47
13	For altering one or more entries of the trade or business address of a registered proprietor or a registered user of a trade mark (unless exempted from fee under Rule 81)—		
	For each entry	6	T.M.-No. 18
14	For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged	16	T.M.-No. 48
15	For cancelling the entry of a trade mark upon the register on the application of the registered proprietor of the trade mark	—	T.M.-No. 22
15a	For striking out goods from those for which a trade mark is registered on the application of the registered proprietor of the trade mark	5	T.M.-No. 23
16	On application under any of the sections 26, 27, 32 and 33, for rectification of the register or removal of trade mark from the register	30	T.M.-No. 26
16a	On application for leave to intervene in proceedings under any of the sections 26, 27, 32 and 33, for rectification of the register or removal of trade mark from the register	24	T.M.-No. 27
17	On request, not otherwise charged, for correction of clerical error or permission to amend application	10	T.M.-No. 20

LIST OF FEES PAYABLE (*Cont'd.*)

	Matter or Proceeding	Amount	Corresponding Form
		£	
18	On request by registered proprietor of a trade mark for entry of disclaimer or memorandum in the register	10	T.M.-No. 24
19	On application under Rule 93 to expunge or vary the registration of a certification trade mark or to vary the deposited regulations of a certification trade mark or of certification trade marks of the same registered proprietor where the regulations are substantially the same	30	T.M.-No. 36
19a	On request by the registered proprietor of a certification trade mark to permit alteration of the deposited regulations thereof—		
	For the regulations of one such registration	30	T.M.-No. 35
	For the same or substantially the same regulations of each other registration proposed to be altered in the same way and included in the same request	4	
20	On application by registered proprietor under Rule 6, for conversion of specification	6	T.M.-No. 45
20a	On notice of opposition to a conversion of the specification or specifications of a registered trade mark or registered trade marks—		
	For one mark	27	T.M.-No. 46
	For every other mark of the same proprietor having the same specification	4	
21	On appeal from the Registrar, otherwise than to the Court, in respect of each decision appealed against, by Appellant	27	T.M.-No. 30
23	On request for the Registrar's preliminary advice under Rule 20, for each trade mark submitted in respect of one class	9	T.M.-No. 29
24	For certificate of the Registrar (other than certification under section 19(2)) of the registration of a trade mark	9	T.M.-No. 31
24a	For certificate of the Registrar (other than certification under section 19(2)) of the registration of a series of trade marks under section 21(2)	9	T.M.-No. 31
25	For certificate of the Keeper of an entry in the Manchester Record relating to one trade mark	9	Textile-No. 5
25a	For certificate of the Keeper of an entry in the Manchester Record relating to a series of trade marks under section 21(2)	9	Textile-No. 5
26	For the continuance of a Cotton Mark in the Collection of Refused Marks—		
	For each mark in each class at the end of each period of fourteen years after date of application	70	Cotton-No. 6

LIST OF FEES PAYABLE (*Cont'd.*)

	Matter or Proceeding	Amount	Corresponding Form
		£	
27	For cancelling or making one or more entries of an address for service of a registered proprietor or a registered user of a trade mark, on application made after the registration in each case—		
	For each entry	4	T.M.-No. 33
27a	For altering one or more entries of an address for service in the register—		
	For each entry	4	T.M.-No. 33
	Total fee in no case to exceed £240 for any number of entries included in one application for alteration, where the address and the alteration in each case are the same.		
28	For inspecting register or Manchester Record, or notice of opposition, counter-statement or decision in connection with any opposition or application for rectification of the register relating to any particular trade mark, for every quarter of an hour	0.90	—
29	For permission to search amongst the classified representation of trade marks, for every quarter of an hour	0.90	—
30	For certifying office copies, MSS, or photographic or printed matter, each	9	—

The fees to be paid on any proceeding at the Manchester Branch and at the office of the Cutlers' Company shall be the same as for the similar proceeding at the Office.

For the purpose of these fees (except as specially provided above) every mark of a series under section 21, or any preceding similar enactment, shall be deemed to be a mark separately registered.

EXPLANATORY NOTE

(*This Note is not part of the Rules.*)

These Rules further amend the Trade Marks Rules 1938 by deleting from the definitions of "the Office" and "the Manchester Branch" in Rule 2(1) of those Rules, from all prescribed forms and from the Notes to Schedule IV to those Rules the addresses of the Trade Marks Registry and its Manchester Branch.

These Rules also amend the Trade Marks Rules 1938 so as to increase the fees payable under them with effect from 22nd July 1985, except in the case of renewal fees paid in advance in respect of a period beginning on or after 22nd July 1985, which are increased with effect from 8th July 1985. It is estimated that the total amount of fees collected per annum at the new levels will be seven per cent greater than the amount collected per annum at the existing levels.

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